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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/483,467 01/13/00 DANNER

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EXAMINER

PM82/0727

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ART UNIT

PAPER NUMBER

3641

DATE MAILED:

07/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/483,467

Applicant(s)

Danner et al.

Examiner

Stephen M. Johnson

Group Art Unit

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☒ Responsive to communication(s) filed on Jan 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-74 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-74 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jan 13, 2000 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☒ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The preliminary amendment filed on 1/13/2000 is improper for the following reasons:
 - a) Each amendment submission must set forth the status of all patent claims and of all added claims (i.e., "pending", "canceled" as of the date of the amendment) (37CFR 1.121(b)(2)ii).
 - b) Pursuant to the provisions of 37 CFR 1.121 (b)(2)(iii), applicant must identify support for the amendments made to the claims of the reissue application. Such has not been done for added claims 41-74.
2. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that **all errors** which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.
3. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
4. The reissue oath/declaration filed with this application is defective because all inventors must sign the oath or declaration (see MPEP 1410.01).
5. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

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A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

6. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

7. Claims 1-74 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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8. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify each inventor by full name, each inventor's residence, post office address, and country of citizenship.

It does not state whether the inventor is a sole or joint inventor of the invention claimed.

It does not state that the person making the oath or declaration believes the named inventor or inventors to be **the original and first inventor or inventors** of the subject matter which is claimed and for which a patent is sought.

9. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the switching means (see claim 1, line 6, claim 47, lines 8-9); the safety (see claim 1, line 12, claims 55, 57, and 63); the threaded firing pin adjustment screw (see claim 5); the threaded aperture (see claim 5); the system control means that is external from the firearm (see claim 10); the secondary discharge path (see claim 31); the safety mechanism (see claim 30); the switch isolation means (see claim 62); and the safety mechanism (see claims 72 and 73) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

10. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

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11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 47-59, 62-63, and 70-74 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims limitations directed to “the firearm being in a nonoperative condition” are unsupported by the application as originally filed.

13. Claims 1-37, 45-46, 49-50, 59, and 70-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 12, the phrase “the safety” lacks an antecedent. In claim 3, lines 24-25, it is not understood as to how the bolt plug detent can bias the bolt plug detent forward. In claim 5, lines 8-9, it is not understood as to how something can be between the firing pin and the firing pin plunger when the firing pin plunger is a part of the firing pin. In claim 7, and in claim 59, it is not understood as to how a system control means can be discrete digital logic, discrete analog logic, or custom integrated logic. Logic is something that is used by a microprocessor or system control means and not the system control means itself. In claims 19, 21 and 25, the phrase “the electrical isolation means” lacks an antecedent. In claim 30, line 2, the phrase “the safety mechanism” lacks

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an antecedent. In claim 45, the phrase “the system control means” lacks an antecedent. In claim 46, the phrase “the voltage increasing means” lacks an antecedent. In claims 49 and 50, how is the term “switching means” intended to relate to the previously claimed ‘switching means’ (see claim 47, lines 8-9)? In claim 70, line 11, the phrase “said voltage supply” lacks an antecedent. Claim 70 contains two periods. In claim 70, line 18, how is the phrase “a voltage supply” intended to relate to the previously claimed ‘voltage supply’? In claim 74, how does the term “a firing pin” relate to the previously claimed ‘firing pin’ (see claim 70, line 5)?

14. Claims 1-74 are rejected under 35 U.S.C. 251.

Whatever the reason that the claims were originally allowed must be retained in any reissue claims, since applicant has “surrendered” claiming his invention of a scope which lacks the “reasons-it-was allowed limitations”. In this case the parent case (08/680,490) makes it clear that the highlighted portions of claims 1 and 38 were the reasons that the claim was allowed (see attachment). All reissue claims must retain those limitations (see MPEP 1412.02).

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1, 7-9, 11-13, 21, 25, 28, 32, 35, 38, 40, 42-43, 45-54, 57, 59-67, and 69-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Harthcock.

Harthcock discloses an electronic firearm and associated method comprising:

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- | | |
|---|---------------------|
| a) monitoring a sequence of operative conditions of a firearm, | 31 |
| b) sending a signal to the control means when the trigger is
actuated, | 83 |
| c) isolating the firing pin from the voltage source upon the
occurrence of failure of firing components, | col. 4, lines 59-63 |
| d) a safety switch, | 51, 52 |
| e) an indicator, and | 47 |
| f) a switch isolating means. | 31 |
17. Claims 38, 40, 42-43, 45, 47, 51, 53, 57, 59-60, 62, 64, and 70-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al..
- Johnson et al. discloses an electronic firearm and associated method comprising:
- | | |
|---|--|
| a) monitoring a sequence of operative conditions of a firearm, | col. 6, lines 18-33;
col. 6, lines 49-65, |
| b) sending a signal to the control means when the trigger is
actuated, | col. 6, lines 43-47 |
| c) isolating the firing pin from the voltage source upon the
occurrence of failure of firing components, | col. 6, lines 18-33 |
| d) a safety switch, | 55 |
| e) an indicator, and | 81 |
| f) a switch isolating means. | 84, 85 |

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18. Any inquiry concerning this communication should be directed to Stephen M. Johnson at telephone number (703)-306-4158.

A handwritten signature in black ink, appearing to read 'S. M. Johnson'.

STEPHEN M. JOHNSON
PRIMARY EXAMINER